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In re Application of : DECISION ON PETITION
CHEUNG, et al. :
U.S. Application No.: 09/743,827 :
PCT No.: PCT/GB99/02267 : UNDER 37 CFR 1.47(a)
Int. Filing Date: 14 July 1999 :
Priority Date: 14 July 1998 :
Attorney Docket No.: LEA33820 :
For: ANTI PARASITIC ARTEMISININ :
DERIVATIVES (ENDOPEROXIDES) :

This decision is in response to applicant's "Petition, Fee and Statement of Facts Supporting a Filing on Behalf of Non-Signing Inventor Under 37 CFR 1.47(a)" filed 31 July 2001 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 14 July 1999, applicant filed international application PCT/GB99/02267, which claimed priority of an earlier application filed 14 July 1998. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 27 January 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 11 February 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 14 January 2001.

On 16 January 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and an Information Disclosure Statement. Applicant did not file an executed oath or declaration of the inventors but did provide the \$130.00 surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date. (14 January 2001 was a Sunday and 15 January 2001 was a Federal holiday, therefore applicant's payment of the basic national fee on 16 January 2001 was considered timely.)

On 09 February 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the

need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 31 July 2001, applicant responded with the present petition to accept the accompanying combined declaration and power of attorney without the signature of inventor William Wai-Lun Lam and a combined declaration and power of attorney executed by the remaining named inventors. Applicant authorized the deduction of the extension fee for a five-month extension of time. Therefore, the petition is considered to be a timely response to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 09 February 2001.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Item (1), applicant has authorized the withdrawal of any further charges from Deposit Account No.: 13-3372. The \$130.00 petition fee will be deducted from said account.

Regarding Item (3), the petition states the last known address of the non-signing inventor, Mr. William Wai-Lun Lam.

As to Item (4), accompanying the petition is a declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor. Accordingly, Items (1), (3) and (4) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Applicant alleges that inventor Lam cannot be found or located. However, no documentary evidence to support the failed attempts was provided with Richard Haynes' declaration. Applicant has not provided any information as to whether a search of telephone directories or Internet search engines were performed in an attempt to find a current address for Dr. Lam.

In addition, it is not clear from the Haynes' declaration that a complete set of papers were ever sent to Dr. Lam at the last known address detailed in the petition. It is possible that Dr. Lam has provided for the forwarding of his mail through the post office and that correspondence sent to his last known address will be forwarded to him. In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Dr. Lam and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Dr. Lam under 37 CFR 1.47(a) at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice.**

The \$130.00 petition fee will be deducted from Deposit Account 13-3372.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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